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APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/015,385	12/12/2001		Kevin P. Baker	GNE.2830P1C51	9906
30313	7590	07/01/2004		EXAM	INER
		NS, OLSON & F	MCKELVEY, TERRY ALAN		
2040 MAIN FOURTEEN				ART UNIT	PAPER NUMBER
IRVINE, CA	92614			1636	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.	Applicant(s)	
10/015,385	BAKER ET AL.	
Examiner	Art Unit	
Terry A. McKelvey	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE $\underline{3}$ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

after SIX (6) MONTHS from the mailing date of this cor If the period for reply specified above is less than thirty If NO period for reply is specified above, the maximum Failure to reply within the set or extended period for rel	(30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication ply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). is after the mailing date of this communication, even if timely filed, may reduce any	ı.
Status		
	iled on 2b)⊠ This action is non-final. In for allowance except for formal matters, prosecution as to the merits is ctice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.	3
Disposition of Claims		
4) Claim(s) 28-47 is/are pending in the 4a) Of the above claim(s) is 5) Claim(s) is/are allowed. 6) Claim(s) 28-47 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to rest	lare withdrawn from consideration.	
Applicant may not request that any ob Replacement drawing sheet(s) includi	the Examiner. ber 2001 is/are: a)⊠ accepted or b)□ objected to by the Examiner. bjection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). ling the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(a) to by the Examiner. Note the attached Office Action or form PTO-152.	d).
Priority under 35 U.S.C. § 119		
a) ☐ All b) ☐ Some * c) ☒ None of: 1. ☒ Certified copies of the priori 2. ☐ Certified copies of the priori 3. ☐ Copies of the certified copies application from the Interna	m for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). Ity documents have been received. Ity documents have been received in Application No The set of the priority documents have been received in this National Stage tional Bureau (PCT Rule 17.2(a)). Ition for a list of the certified copies not received.	
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review 3) Information Disclosure Statement(s) (PTO-1449 Paper No(s)/Mail Date 9/02.		

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DETAILED ACTION

Priority

According to the priority statement of 9/9/02 (in related application 10/006,856), it appears that the claimed subject matter defined in the instant application is alleged by the applicant to be supported by the parent application no. 60/100,584, filed 9/16/98. However, based upon the information given by applicant and an inspection of the patent applications, the examiner has concluded that the subject matter defined in this application is supported by the disclosure in application no. PCT/US00/04342, filed 2/18/00 but is not supported by any of the other earlier filed applications because in the earlier applications, the claimed invention lacks specific and substantial utility and thus correspondingly lack enablement under 35 USC 112, first paragraph. Prior to the application filed 2/18/00, the earlier applications merely indicate that the protein encoded by the claimed nucleic acids have some degree of similarity to neuropsin, a serine protease. The only disclosed utilities for the nucleic acid is for encoding the protein, or non-specific and non-substantial general utilities such as use as a probe. There is no well-

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established utility for these uses because the actual function of the protein encoded by the claimed nucleic acid is not known or disclosed by the earlier applications. application-asserted utilities are not specific and substantial because some sequence similarity (about 50%) to a particular serine protease, neuropsin, as indicated in the rejection below, does not provide any information about the specific target of the new serine protease (assuming it is one) and thus one would not know what the specific utility of the protein (and thus the specific utility of the nucleic acid). It lacks a substantial utility because it would require carrying out further research to determine the specific target of the alleged serine protease so that a specific utility for the nucleic acid encoding the protein could be determined. Accordingly, because the applications filed before 2/18/00 fail to provide a specific and substantial utility for the claimed nucleic acids, the skilled artisan would not know how to use the nucleic acids which lack a specific and substantial utility. Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

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The subject matter defined in claims 28-47 have the effective filing date of 2/18/00.

Should the applicant disagree with the examiner's factual determination above, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to 2/18/00 which specifically supports the particular claim limitation for each and every claim limitation in all pending claims which applicant considers to have been in possession of and fully enabled for prior to 2/10/00.

Also, applicants are requested to provide a similar concise claim of priority for the instant application that is supplied in the two PRO1303-related applications, 10/006,856 and 10/006,116.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-32, 39-40, and 44-47 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid having

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encoding the polypeptide of SEQ ID NO:194 or the mature form thereof (or drawn to a nucleic acid encoding a polypeptide having the function of affecting glucose or FFA uptake by primary rat adipocytes), does not reasonably provide enablement for an isolated nucleic acid not identical to a nucleic acid encoding at least the mature form of SEQ ID NO:194 or a nucleic acid which encodes a polypeptide which does not have this activity. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is undue include, but are not limited to: nature of the invention, the state of the prior art, the predictability or lack thereof in the art, the amount of direction or guidance present, the presence or absence of working examples, the quantity of experimentation necessary, the relative skill levels of those in the art, and the breadth of the claims.

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The claims are drawn to a nucleic acid having at least 80% nucleic acid identity to a nucleic acid encoding a polypeptide of SEQ ID NO:194 or the extracellular domain thereof, both referred to as PRO1303. There is no functional limitation to the polypeptides encoded by the nucleic acid in the claims. Applicants have taught the polypeptide consisting of the extracellular domain or, more accurately, the mature form of SEQ ID NO:194, as well as the putative signal sequence. This polypeptide was shown to affect glucose or FFA uptake by primary rat adipocytes on the basis of an assay measuring this activity (Example 149, pages 511-512).

The claim encompasses an unreasonable number of inoperative nucleic acids because they encompass nucleic acids not encoding a polypeptide and nucleic acids encoding polypeptides having no functional limitation, which nucleic acids or proteins encoded by the nucleic acids the skilled artisan would not know how to use. While the specification suggests that the polypeptide of SEQ ID NO:194 is a serine protease related to neuropsin, the specific substrate specificity is undisclosed. Since PRO1303 is a secreted protein, it would be expected that the mature form would be sufficient for function in the absence of the secretory

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signal. As opposed to the claims, what is disclosed about PRO1303 is narrow: nucleic acids encoding a single polypeptide with two disclosed functions and no other obvious specific functions. The skill in the serine protease art is not high because there are several different classes of serine proteases and even within classes, such as human kallikreins, which the instant polypeptide is a member of, each family member exhibits a high degree of substrate specificity (which is different for each family member) (Yousef et al, Anticancer Research, Vol. 19, pages 2843-2852 (1999), see page 2843, column 2). Therefore, knowledge of one serine protease's structure and function does not provide predictability about function of a structurally related serine protease, even within the same class.

There are no working examples of nucleic acids that are less than 100% identical to the nucleic acids that encode the polypeptide of SEQ ID NO:194 or the mature form thereof. The skilled artisan would not know how to use non-identical nucleic acids or the encoded non-identical polypeptides on the basis of teachings in the prior art or the specification unless they encode polypeptides that possess the glucose or FFA uptake function disclosed in the

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instant specification. While the specification generally describes properties of serine proteases, it is acknowledged by the cited art that serine proteases such as kallikreins are diverse in function and structure. The specification does not provide guidance for using nucleic acids related to (i.e., 80%-99% identity) but not identical to nucleic acids encoding a polypeptide of SEQ ID NO:194 which do not encode a polypeptide that has the disclosed activity shown for PRO1303. The claims are broad because they do not require the polypeptide encoded by the claimed nucleic acid to be identical to the disclosed sequence and because the claims have no functional limitation.

For these reasons, which include the complexity and unpredictability of the nature of the invention and art in terms of the diversity of serine proteases and lack of knowledge about function9s) of encompassed polypeptides structurally related to SEQ ID NO:194, the one limited working example of nucleic acid encoding PRO1303 polypeptide which has its one demonstrated function, affecting glucose or FFA uptake by adipocytes, the lack of direction or guidance for using nucleic acids that encode polypeptides that are not identical to at least the extracellular domain of SEQ ID NO:194, and the breadth of

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the claims for structure without function, it would require undue experimentation to use the invention commensurate in scope with the claims.

Claims 28-32, 39-40, and 44-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to a nucleic acid having at least 80%, 85%, 90%, 95%, or 99% nucleic acid sequence identity to a nucleic acid encoding a polypeptide of SEQ ID NO:194 or the extracellular domain thereof, both referred to as PRO1303. The claims do not require that the nucleic acid encode a polypeptide that possesses any particular biological activity, nor any particular conserved structure, or other disclosed distinguishing feature. Thus, the claims are drawn to a genus of nucleic acids that is defined only by sequence identity.

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To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In the instant case, the only factor present in the claims is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing characteristics, the specification does not provide adequate written description of the claimed genus.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented

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what is now is claimed." (See Vas-Cath at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation or identification. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See Fiers v. Revel, 25USPQ2d 1601 at 1606 (CAFC 1993) and Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 18USPQ2d 1016.

One cannot describe what one has not conceived. See Fiddes v. Baird, 30 USPQ2d 1481 at 1483. In Fiddes, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only isolated nucleic acids encoding polypeptides comprising the amino acid sequence set forth in SEQ ID NO:194, but not the full breadth of the claims meets the written description provision of 35 U.S.C. 112, first paragraph. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 U.S.C.

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112 is severable from its enablement provision (see page 1115).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The protein identified as PRO1303 is a soluble protein, and is not disclosed as being expressed on a cell surface. Accordingly, the limitation that the claimed polypeptide comprises an "extracellular domain" (for example, see claim 23 (c) and (d)) is indefinite, as the art does not recognize soluble proteins as having such domains. Further, if the polypeptide had an extracellular domain, the recitation of "the extracellular domain" ... "lacking its associated signal sequence" (claim 23 (d), for example) is indefinite because a signal sequence is not generally considered to be part of an extracellular domain, since signal sequences are cleaved from said domains in the process of secretion from the cell.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-37, 41-44, and 46 are rejected under 35 U.S.C. 102(a) as being anticipated by Yousef et al.

Yousef et al teach an isolated nucleic acid which is a genomic clone (Reversed contig 37, Figure 1; Table VI) which encodes KLK-L5, which has 100% identity to SEQ ID NO:194 (although Yousef et al only identify some of the exons encoded by the genomic DNA which are a part of KLK-L5). Even though the precise polypeptide sequence and isolated complete protein is not taught by the reference, the genomic nucleic acid encoding the protein is taught and would be expected to have 100% nucleic acid identity to a

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nucleic acid encoding SEQ ID NO:194, SEQ ID NO:194 without the signal peptide, and the "extracellular domain" of SEQ ID NO:194. See the attached sequence comparison. Vectors comprising the isolated nucleic acid and host cells comprising the vector, are also taught (Figure 1).

Claims 41-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Ni et al (U.S. Patent No. 6,566,498 B1).

Ni et al (at Figure 3; columns 22-23) teach an isolated nucleic acid which has a high degree of identity to SEQ ID NO:193 (97.9%) over a large part of the sequence (about 500 base pairs). See the attached sequence comparison. This large region of near identity is more than sufficient in length to support hybridization with SEQ ID NO:193 under stringent conditions. Vectors comprising the isolated nucleic acid and host cells comprising the vector, wherein the nucleic acid is operably linked to control sequences recognized by a host cell transformed with the vector, such as E. coli or yeast cells, are also taught (columns 22-23).

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Conclusion

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 703-872-9306. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days.

Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (571) 272-0775. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as

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possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.

Terry A. McKelvey, Ph.D.

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Primary Examiner Art Unit 1636

June 27, 2004

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Retailed Action
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Copyright (c) 1993 - 2004 Compugen Ltd
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    IsoId=Q9UKR0-1; Sequence=Displayed;
Name=2;
IsoId=Q9UKR0-2; Sequence=VSP 005403;
IsoId=Q9UKR0-2; Sequence=VSP formally S1. Kallikrein subfamily.
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518 37.7 246 1 TRYB RAT 513.5 37.4 231 1 TRYZ SALSA 513.5 37.4 231 1 TRYZ SALSA 513.5 37.4 239 1 KLK2 CAVPO 510.5 37.2 261 1 KLK3 MOUSE 508 37.0 242 1 TRY1 SALSA 505 36.8 260 1 ESTA_CANFA 505 36.8 260 1 ESTA_CANFA 503 36.6 263 1 KLKC RAT 501 36.5 259 1 KLKC RAT 501 36.5 247 1 TRYZ GADMO 498 36.2 254 1 KLK4_HUMAN	37.7 246 1 37.4 231 1 37.4 239 1 37.2 261 1 37.0 261 1 37.0 261 1 36.8 263 1 36.6 263 1 36.5 247 1 36.4 241 1 36.2 254 1
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	P32822 P36374 P35032 P12323 P10756 P35031 P05031 P05031 P061376 P36376 P01041 Q9y5k2

ALIGNMENTS
JT 1 HUMAN
KR1;
Oraniata. Watching
EUKATYOTA; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi; Mammalia; Eutheria; Primates; Catarrhini; Hominidae; Homo. NCBI_TaxID=9606; [1]
SEQUENCE FROM N.A. (ISOFORM 1). MEDLINE=20118156; PubMed-10655563.
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(3) (3) (1505) CO the EMBL/GenBank/DDBJ databases.
0; PubMed=11054574;
g K.;
[4] SEDIFINCE FROM N & (ISORORM 2)
Lamerdin J.B., McCready P.M., Skowronski E., Viswanathan V., Burkhart-Schultz K., Gordon L., Dias J., Ramirez M., Stilwagen s
A., Brower A., Gar escu A., Avila J.,
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Arellano A., Sanders C., Ow D., Nolan M., Trong S., Kobayashi A.,
"Sequence analysis of chromosome 19q13.4."; Submitted (OCT-2000) to the EMBL/GenBank/DDBJ databases.
LULAR LOCATION: Secreted (Probable)
Mame=1; IsoId=Q9UKR0-1; Sequence=Displayed;

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PRINTS; PR00722; CHYMOTRYPSIN.

SMART; SM00020; Tryp_SPc; 1.

PROSITE; PSS0240; TRYPSIN_DOM; 1.

PROSITE; PS00134; TRYPSIN_HIS; 1.

PROSITE; PS00135; TRYPSIN_SER; 1.
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GO; GO:0004252; F:serine-type endopeptidase activity; NAS.
GO; GO:0006508; P:proteolysis and peptidolysis; NAS.
InterPro; IPR009003; Cys Ser trypsin.
InterPro; IPR001254; Peptidase_S1.
InterPro; IPR001314; Peptidase_S1A.
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EMBL; AF135025; AAF06065.1;
EMBL; AF243527; AAG33365.1;
EMBL; AC011473; AAG23258.1;
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                                                                                                                                                                                     TSSVQPLPLPNDCATAGTECHVSGWGITNHPRNPFPDLLQCLNLSIVSHATCHGVYPGRI
                                                                                                                                                               TSSVQPLPLPNDCATAGTECHVSGWGITNHPRNPFPDLLQCLNLSIVSHATCHGVYPGRI
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                                                                                                         TSNMVCAGGVPGQDACQGDSGGPLVCGGVLQGLVSWGSVGPCGQDGIPGVYTYICKYVDW
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Pred. No. 1.7e-105;
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BB473E98F8BAF703 CRC64;
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RESULT 2
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REPUBLICE OF 1-164 FROM N
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15-JUL-1999 (Rel. 34, Created,
15-JUL-1999 (Rel. 38, Last sequence update)
15-MAR-2004 (Rel. 43, Last annotation update)
15-MAR-2004 (Rel. 43, Last annotation update)
15-MAR-2006 (Rel. 43, Last annotation update)
15-MAR-2008 (Rel. 43, Last annotation update)
15-MAR-2008 (Rel. 43, Last annotation update)
15-MAR-2008 (Rel. 43, Last sequence update)
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Yoshida S., Tanigu
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Mammalia; Eutheria; Primates; Catarrhini; Hominidae; Homo
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Gan I., Gelinas R., Gown A.M., Moss P., Smith R., Wang K.;

"Molecular cloning and characterization of a novel serine protease,

ovasin, a potential molecular marker for ovarian carcinomas.";

Submitted (SEP-1998) to the EMBL/GenBank/DDBJ databases.
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Moss P., Paeper
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O'Brien T.J.;
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Smith R., Argonza-Barrett R., Lei
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animoto H., Wang Y.,
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Mi,J. and Ruben, S.M.
Human serine protease and serpin polypeptides
Patent: US 6566498-A 5 20-MAY-2003;
Location/Qualifiers
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                                              ACCAATATCTCCTCCATCACTTCCCCTAGCTCCACTCTTGTTGGCCTGGGAACTTCTTGG
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                                                                                           CTGTTTCCTCCACCTCCACCCCCACCCCTTAACTTGGGTACCCCTCTGGCCCTCAGAGG
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Query Match
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Matches 513; Conserv
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                                                                                                                                                                                                                                                                                                                               628 GCCACCTGCCATGGTGTGTATCCCGGGAGAATCACGAGCAACATGGTGTGTGCAGGCGGC
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Ruben, S.M. and Ni, J.
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                      CCTGTTTCCTCCACCTCCACCCCCACCCCTTAACTTGGGTACCCCCTCTGGCCCTCAGAGC
                                                                        GTCTACACCTATATTTGCAAGTATGTGGACTGGATCCGGATGATCATGAGGAACAACTGA
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un serine protease and serpin polypeptide
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/mol_type="genomic DNA"
/db_xref="taxon:9606"
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